

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY W. WOODWARD, BRAD B. HECKERMAN and DENNIS A. MEUCHEL

Appeal No. 2001-2421
Application No. 09/092,577¹

ON BRIEF

Before BARRY, LEVY and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-17, which are all the claims pending in this application.

We reverse.

BACKGROUND

Appellants' invention is directed to lighting systems with both hard wire and fiber optic illumination capabilities for

¹ Application for patent filed June 5, 1998, which is a continuation-in-part of the Application No. 08/401,717, filed March 10, 1995, now U.S. Patent No. 5,775,896.

dental hand pieces. Representative independent claims 1 and 9 are reproduced below:

1. A system for conducting light to a handpiece, said system comprising:

a light-conducting core extruded into a tubular sheath to form a light-transmitting bundle, said bundle having a first end structured to terminate in a window capable of receiving light from a light source and a second end capable of emitting light conducted by said bundle from said first end;

a first coupling fixture associated with said first end structured and arranged to interface with a light source; and

a second coupling fixture associated with said second end and structurally adapted for connection to a handpiece, whereby to furnish illumination through said handpiece.

9. A system for conducting light to an optic device, said system comprising:

a bundle of flexible, light-conducting fibers, said bundle having a first end structured to terminate in a window capable of receiving light from a light source and a second end capable of emitting light conducted by said bundle from said first end;

a first coupling fixture associated with said first end, structured and arranged to hold said window in association with a light source;

a second coupling fixture associated with said second end and structurally adapted for connection to a receptacle carried by said optic device, said second coupling fixture comprising a spring biased terminal end segment of said bundle including said second end.

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The Examiner relies on the following references in rejecting the claims:

Miller et al (Miller)	5,099,399	Mar. 24, 1992
Scrivo	4,579,419	Apr. 1, 1986

Declaration of Assignee signed by Brad B. Heckerman on September 24, 1998 (Paper No. 5, filed November 9, 1998).

Claims 1-17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Appellants' statement that the invention was entered into a sale contract.

Claims 9 and 10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Scrivo.

Claims 1-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller.

Claims 11-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Scrivo in view of Miller.

Claims 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Scrivo or Miller.

We make reference to the answer (Paper No. 17, mailed April 24, 2001) for the Examiner's reasoning, and to the appeal brief (Paper No. 14, filed November 24, 2000) and the reply brief (Paper No. 18, filed May 21, 2001) for Appellants' arguments thereagainst.

OPINION

With respect to the 35 U.S.C. § 102 rejection of claims 1-17, Appellants argue that the agreement between the assignee and the inventor relates to a general transfer of technology, including some disclosed in this application, and "cannot properly be construed to constitute a commercial sale of a complete invention" (brief, page 2 and reply brief, page 1). Appellants point out that agreements made by employees that any invention made within their scope of employment are property of the employer have never constituted a statutory bar under Section 102 (brief, page 3). In response, the Examiner merely points out that the document labeled "Bill of Sale" does not appear to be an employment agreement and meets the time frame under Section 102(b) (answer, page 5).

Upon a review of the record before us, we find that the agreement which the Examiner regards as a "sale contract" and a statutory bar, in effect, is an agreement between an employee and an employer for transferring the right to an invention made within the scope of that employee's employment. Although the agreement is labeled "Bill of Sale,"² its content does not reflect a commercial sale but, in fact, indicates that the

² Attached as Exhibit A to the declaration signed by the assignee (Paper No. 7, filed November 9, 1998).

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inventor has merely assigned the invention to the assignee. An assignment or sale of the rights in an invention, and potential patent rights is not a sale of "the invention" within the meaning of Section 102(b). Moleculon Research Corp. v. CBS, Inc., 793 F.2d 1261, 1267, 229 USPQ 805, 809 (Fed. Cir. 1986). Therefore, we do not sustain the 35 U.S.C. § 102 rejection of claim 1-17.

Turning now to the 35 U.S.C. § 102 rejection of claims 9 and 10 over Scrivo, Appellants argue that the prior art reference does not disclose the claimed second coupling fixture comprising a spring biased terminal end segment (brief, page 3). Appellants assert that spring 50 of Scrivo, as characterized by the Examiner to provide the biasing function (answer, page 6), is a conventional strain relief spring for preventing the enclosed fiber bundle from bending at too sharp an angle and does not include the recited "second end" (reply brief, page 2).

A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. See Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947

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(Fed. Cir. 1999); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

After reviewing Scrivo, we agree with Appellants' assertion that the claimed second coupling fixture comprising a spring biased terminal end segment is not the same as the strain relief spring 50 shown in Figure 4 of the reference. Scrivo, as shown in Figure 2, discloses a conventional strain relief spring 50 and a connector assembly 52 that connects flexible tubing 48, containing fiber optic bundle 42, to opening 38 in illumination system housing 32 (col. 3, lines 27-43). We also find that strain relief spring 50 in Figure 4, in conjunction with stainless steel ferrule 54 and stainless steel tube 56, provides a transition area to convert fiber bundle 44 having a circular cross section (col. 4, lines 6-10) to a semi-circular cross section to be fitted in termination tubing 56 (col. 3, lines 52-57). Therefore, we remain unpersuaded by the Examiner's characterization of the strain relief spring 50 as the spring biased terminal end segment of the fiber optic bundle that includes the second end for emitting light received from a first end, as recited in claim 9. We further note that the strain relief spring 50 of Scrivo is not only different from the claimed coupling fixture comprising a "spring biased terminal end

segment," it also lacks the recited second end as spring 50 of Scrivo is not positioned such that the bundle of fibers can emit light conducted by the first end at the other end of the fiber bundle. As depicted in Figure 4 of Scrivo, the cross-section of the bundle of fibers changes from a circular shape to that of a semi-circular as it passes through socket 62 and continues into the termination tube 56 and therefore, what the Examiner characterizes as the spring biased end segment, is not an end segment of the fiber bundle that includes the second end. Thus, since all the limitations of the appealed claims are not taught, Scrivo cannot anticipate the claims. Accordingly, the 35 U.S.C. § 102 rejection of claims 9 and 10 is not sustained.

Turning to the 35 U.S.C. § 103 rejection of claims 1-7 over Miller, the Examiner asserts that the reference teaches all the recited elements except for its connection to a handpiece, but finds the use of such handpiece a well known modification (answer, page 4). The Examiner further points out that the final product of the claimed process is the same as that of the prior art and requires Appellants to show error by providing evidence to show that the claimed process results in improved product (answer, page 6).

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In response, Appellants argue that although the claims are directed to a structure, the claims include "a light conducting core extruded into a tubular sheath" as a structural component (brief, page 3). Appellants point out that the "light guide 15" of Miller is a conventional structure formed of a bundle of fibers and is not the same as the claimed tubular sheath (id.). Additionally, Appellants question the propriety of the Examiner's requirement for showing improvement of the claimed process over that of the prior art (reply brief, page 2).

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under § 103, the examiner must produce a factual basis supported by teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Such evidence is required in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The Examiner must not only identify the elements in the prior art, but also show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine

the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Miller relates to a fiber optics illuminator wherein a source of illumination for plastic fiber bundle light guides is provided (col. 1. Lines 8-11). As depicted in Figure 2, light from light source 2 falls on a first end of glass rod 9 and travels along the length of the glass rod to be received by fiber optics light guide 15 which is made of one or a plurality of optical fibers in a bundle (col. 3, lines 54-66). As pointed out by Appellants (brief, page 3), absent any teachings in Miller that suggests a light transmitting core in the form of tubular sheath, the disclosed optical fibers are of conventional fiber type and not in the form of tubular sheath. Therefore, contrary to the Examiner's proposed modification of the fiber bundle of Nash to be used with a handpiece, we do not find any teaching or suggestion in Miller that supports the factual basis and the obviousness of the proposed modification. The Examiner has further failed to establish how the glass rod and the fiber bundle of Nash that are merely positioned with their ends in contact with each other, read on the recited first and the second coupling fixtures. Thus, we find that the Examiner has failed to set forth a prima facie case of obviousness and the 35 U.S.C. § 103 rejection of claims 1-7 over Miller cannot be sustained.

With respect to the 35 U.S.C. § 103 rejection of claims 11-15 over Scrivo in view of Miller, We note that the Examiner relies on Miller for disclosing the first coupling system (answer, pages 4 & 5). However, we find nothing in Miller that relates to the claimed spring biased terminal end segment that would have cured the above-noted deficiency of Scrivo with respect to the recited features of base claim 9 from which claims 11-15 depend. Accordingly, we do not sustain the rejection of claims 11-15 under 35 U.S.C. § 103 over Scrivo in view of Miller.

Turning now to the 35 U.S.C. § 103 rejection of claim 17 over Scrivo or Miller, Appellants point out that the Examiner has not provided a valid reason for modifying Scrivo or Miller and add an infra red blocking means between the first and the second couplers (brief, page 3). Appellants add that the references do not suggest that an infra red locker would be useful or the claimed optical fibers could or should be protected from the effects of infra red radiation (brief, page 4).

We remain unpersuaded by the Examiner's reasoning (answer, page 6) that it would have been obvious to use an infra red blocker "so that the devices can be safely used in the medical field" as the Examiner has failed to point to some teaching in the prior art or the knowledge generally available to one of ordinary skill in the art that would have suggested the proposed

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modification. As pointed out by our reviewing court, "the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). Here, we do not find that the Examiner's findings and reasoning satisfy this requirement. Accordingly, we do not sustain the obviousness rejection of claim 17 over Scrivo or Miller.

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CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-17 under 35 U.S.C. § 102 and rejecting claims 1-7, 11-15 and 17 under 35 U.S.C. §103 is reversed.

REVERSED

LANCE LEONARD BARRY)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
STUART S. LEVY)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
MAHSHID D. SAADAT)	
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